

Application No. 10/051,263
Docket No. 10003897-1

REMARKS

Claims 1-24 are pending in the application. In the Office Action of December 1, 2004, claims 1-3 and 7-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,609,106 ("Robertson"). Claims 4-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Robertson as applied to claim 1 and further in view of U.S. Patent No. 6,601,057 ("Underwood"). Applicant respectfully traverses these rejections for the following reasons.

An electronic commerce system of Applicant's invention comprises a server connected to a network and (the server) having a processor and storage. The storage includes a custom catalog listing products using a unique product identification (PID) generated by the processor for each of the products. The PID has recipient information encoded therewith. The product identification (PID) is generated and assigned for each item selected by the recipient for listing in the catalog. The PID uniquely identifies both the recipient and the selected item. A unique PID is generated for each of the items (Specification ¶ 0021).

In rejecting claim 1, the Office Action relies on Robertson (Fig. 2; col. 9, line 55 to col. 10, line 35 and col. 13, lines 49-67) for describing Applicant's invention as recited in claim 1 (as well as independent claims 15 and 22).

In Robertson, a "unique ID" is assigned by the Registrar to a user for enabling the user to add "items of interest" to the user's "wish" list (col. 9, lines 61-63 and col. 13, lines 63-65). In describing Fig. 2 of Robertson, the unique identifier is also described as being used to "tag" items of interest at participating service providers' (SP) sites. This unique ID is also given to a service provider by the Registrar and is stored with the user's items of interest (col. 10, lines 14-16).

Application No. 10/051,263
Docket No. 10003897-8

While Robertson may associate a list of items with a user based on the user's unique ID, Robertson simply fails to disclose generating and assigning unique product identification for each product listed in a catalog. Robertson generates one ID that is used for adding items to a list, tagging items of interest at participating SP sites and for associating the chosen items. As such, Robertson does not generate a unique PID with encoded recipient information for each product listed in a custom catalog. On the contrary, the unique ID of Robertson is used for multiple purposes.

In contrast to Robertson, a unique PID having encoded recipient information is generated for each product listed in a custom catalog in Applicant's invention. The generated unique PID is used for identifying the particular product and not for other purposes such as tagging items of interest, adding items to a list, etc.

The Examiner cites the use of unique product identification for individual products such as a VIN (vehicle identification number for an automobile) or a serial number of a product as examples. These product identification numbers are typically assigned during manufacturing of the product and prior to having a user associated therewith if such an association were to take place. It should also be pointed out that a VIN (alphanumeric string) for example can be decoded easily as each digit/letter or combination of digits/letters represents well known fields such as country of manufacturer, name of manufacturer, body style, options, etc.

The unique PID of Applicant's invention is generated based on item name or item number or a SKU in combination with recipient information (See Specification, ¶ 0022). In some embodiments, the unique PID may also be associated with a person requesting the catalog, the registry, or a combination, etc. (See Specification, ¶ 0027).

Application No. 10/051,263
Docket No. 10003897-1

Furthermore, there is no motivation or suggestion in Robertson for utilizing such individual product identification (i.e. VIN etc.). The motivation cited by the Examiner for such combination is improper since Robertson fails to disclose or suggest a need for tracking individual products for warranty or service purposes.

Robertson, therefore, fails to teach Applicant's invention as claimed. At least for these reasons, it is respectfully submitted that independent claims 1, 15 and 22 are patentably distinguishable over Robertson.

The remaining claims (i.e. 2-14, 16-21, 23 and 24), all of which depend on one of claims 1 and 15 and cite additional advantageous features thereof, are also patentably distinguishable over Robertson.

In addition, with respect to claims 4-6, Underwood fails to overcome the deficiencies of Robertson highlighted above.

Robertson also fails to disclose a PID identifying a registry as recited in claim 3. The portions of Robertson relied upon for allegedly teaching this feature (col. 14, lines 40-65) describe user authentication information based presumably also on the "unique ID" described above.

With respect to claim 10, the portions of Robertson relied upon for disclosing means for accepting suggestions for products for inclusion into the custom catalog (col. 10, lines 32-44) describe tagging items of interest and not accepting suggestions.

As recited in claim 13, the PID includes information on participants such as a person requesting the catalog, the registry, or a combination (See Specification, ¶ 0027); this feature is also not disclosed in Robertson.

In claim 19, the use of partial purchase of an item is recited. The assertion that this is

Application No. 10/051,263
Docket No. 10003897-1

well known is respectfully traversed. The Examiner is urged to provide evidence of this fact as typically when a number of people purchase a gift item together, one of the number of people pays the entire amount for an item and receives reimbursement from others.

For at least those reasons presented above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1-24 in view of Robertson or in combination with Underwood.

All of the rejections having been overcome, it is respectfully submitted that this application is in condition for allowance and a notice to that effect is earnestly solicited. Should the Examiner have any questions with respect to expediting the prosecution of this application, he is strongly urged to contact the undersigned at the number listed below.

Respectfully submitted,

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